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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,980	03/15/2004	Pekka Pihlaja	944-003.212	2504

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EXAMINER

AMADIZ, RODNEY

ART UNIT	PAPER NUMBER
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2629

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/801,980	PIHLAJA, PEKKA	
	<b>Examiner</b>	<b>Art Unit</b>	
	Rodney Amadiz	2629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/1/2004</u> .  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

***Claim Objections***

1. Claims 8 and 16 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. As to claims 8 and 16, Examiner is not sure whether the "User input device" is another user input device or if it's referring to the "joystick" of claims 1 and 10. Examiner has interpreted the claim as the latter and therefore the claims are not further limiting their respective independent claims.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4, 5, 7-11, 13-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Oross et al. (U.S. Patent 6,826,042—herein referred to as "Oross").

As to **Claim 1**, Oross teaches a portable electronic device (***Fig. 4, Reference Element 100c***) comprising: a user input device (***Fig. 4b, Reference Element 210c and 214c***) comprising an elongated element (***Fig. 4b, Reference Element 210c***) having a first end and a second end disposed opposite said first end (***See Fig. 4b***), wherein the user input device has a first configuration in which the elongated element is nested within a recess defined in the surface of the portable electronic device and having a size and shape conforming to the surface contour of the portable electronic device whereby the elongated element forms a part of the surface of the portable electronic device in the region of the recess (***Fig. 4a, note Reference Number 210c in the stowed position and Col. 5, lines 40-58***), and a second configuration in which the elongated element is in an extended position with respect to the surface of the portable electronic device wherein in the second configuration the user input device is operable as a joystick (***Figs. 4b and 4c and Col. 5, lines 40-65***).

As to **Claim 9**, Oross teaches a user input device for a portable electronic device (***Fig. 4b, Reference Element 210c and 214c***), comprising: an elongated element (***Fig. 4b, Reference Element 210c***) having a first end and a second end disposed opposite said first end (***See Fig. 4b***), wherein the user input device has a first configuration in which the elongated element is nested within a recess defined in the surface of the portable electronic device and having a size and shape conforming to the surface contour of the portable electronic device whereby the elongated element forms a part of the surface of the portable electronic device in the region of the recess (***Fig. 4a, note Reference Number 210c in the nested position and Col. 5, lines 40-58***), and a

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second configuration in which the elongated element is in an extended orientation with respect to the surface of the portable electronic device wherein in the second configuration the user input device is operable as a joystick (***Figs. 4b and 4c and Col. 5, lines 40-65***).

As to **Claim 10**, Oross teaches an electronic device (***Fig. 4, Reference Element 100c***), comprising: a user input device (***Fig. 4b, Reference Element 210c and 214c***) comprising an elongated element (***Fig. 4b, Reference Element 210c***) having a first end and a second end disposed opposite said first end (***See Fig. 4b***), wherein the user input device has a first configuration in which the elongated element is nested within a recess defined in the surface of the portable electronic device in a restricted inoperative position (***Fig. 4a, note Reference Number 210c in the restricted inoperative position and Col. 5, lines 40-58***), said elongated element having a size and shape conforming to the surface contour of the portable electronic device whereby the elongated element forms a part of the surface of the portable electronic device in the region of the recess (***See Fig. 4a***), and a second configuration in which the elongated element is in an extended operative orientation with respect to the surface of the portable electronic device wherein in the second configuration the user input device is operable as a joystick (***Figs. 4b and 4c and Col. 5, lines 40-65***).

As to **Claim 17**, Oross teaches a user input device for an electronic device (***Fig. 4, Reference Element 100c***), comprising: an elongated element (***Fig. 4b, Reference Element 210c***) having a first end and a second end disposed opposite said first end (***See Fig. 4b***), wherein the user input device has a first configuration in which the

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elongated element is folded into a recess defined in the surface of the electronic device whereby the elongated element forms a part of the surface of the portable electronic device in the region of the recess (**Fig. 4a, note Reference Number 210c in the folded/stowed position and Col. 5, lines 40-58**), and a second configuration in which the elongated element is in an unfolded extended orientation with respect to the surface of the electronic device wherein in the second configuration the user input device is operable as a joystick (**Figs. 4b and 4c and Col. 5, lines 40-65**).

As to **Claim 4**, Oross teaches the user input device arranged to operate as an analog user input device (**Col. 5, lines 59-65**).

As to **Claims 5 and 13**, Oross teaches that the portable electronic device is pocket sized and for handheld usage (**Col. 2, lines 37-45**).

As to **Claims 7 and 14**, Oross teaches that the portable electronic device is operable as a mobile cellular telephone (**Col. 2, lines 37-45**).

As to **Claims 8 and 16**, Oross teaches a user input device (**Fig. 4b, Reference Elements 210c and 214c**) for a portable electronic device (**Fig. 4, Reference Element 100c**).

As to **Claim 11**, Oross teaches means for unfolding the elongated element to its extended orientation in response to a first user action and for folding the elongated element to its nested position in response to a reversal of the first user action (**See Figs. 4a-4c and Col. 5, lines 40-58**).

As to **Claim 15**, Oross teaches that the electronic device is operable as a gaming device (***Col. 15, line 66—Col. 15, line 3***).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oross.

As to **Claim 3**, Oross does not teach the recess defined in the surface of a navigational device carried on the portable electronic device. However the specification shows no apparent benefits for having the recess defined in the surface of a navigational device. Therefore, having a recess defined on any surface of a portable device including that of a navigational device is clearly a design choice based on the specific requirement of the claim. In addition Oross does teach that the joystick can be mounted on any region of the computing device (***Col. 2, lines 29-36***). Furthermore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to place the recess on any surface of the portable electronic device including the surface of a navigational device carried on the portable electronic device since the joystick would perform equally well on any surface of the portable electronic device.

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5. Claims 2, 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oross in view of Haywood (USPGPUB 2003/0214484—herein referred to as “Haywood”).

As to **Claims 2 and 12**, Oross fails to teach the elongated element hingedly connected at its second end for pivotal movement about the hinge axis wherein said elongated element is folded about the hinge axis in said first configuration and unfolded about the hinge axis in said second configuration. Examiner cites Haywood to teach an elongated element that is hingedly connected at its second end for pivotal movement about the hinge axis wherein said elongated element is folded about the hinge axis in said first configuration and unfolded about the hinge axis in said second configuration (***Figs. 4-6a and Pg. 5, ¶ 45***). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the use of a hinge as taught by Haywood in the elongated element taught by Oross so that the joystick may pivot with ease.

As to **Claim 6**, Oross teaches the elongated element mounted at its second end for pivotal movement wherein pivotal movement of the user input device is restricted in the first configuration and the user device pivots freely in the second configuration (***Oross—Fig. 4a and 4b and Col. 5, lines 40-65***).



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***Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney Amadiz whose telephone number is (571) 272-7762. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz can be reached on (571) 272-3638. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*R.A.*

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12/8/06

  
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